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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,591	01/20/2006	Richard Merken-Schiller	HO-P03195US0	9719
26271 7590 07/24/2008 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
EXAMINER				
DURAND, PAUL R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,591

Applicant(s)

MERKEN-SCHILLER ET AL.

Examiner

Paul R. Durand

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/3/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-9, 14, 15, 17-21, 25, 27 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson (US 4,246,223) in view of Ellison et al. (US 2002/0079611).

In claim 1, Patterson discloses the invention as claimed including permanently deforming a sheet of film 28, by providing a positive and negative molds 54 and 52 respectively, having an edge portion and upper portion, forming depressions 70, in the film material, where the tension is controlled and maintained by draw pads 100, while forming controlled creases (in the area of 36) around the edges of the material, while the upper edge (i.e. the clamped edges) are kept in a flat original shape (See figures 2, 3, 6, 7 and col. 3, line 43 – col. 4, line 64). What Patterson does not disclose is the reduction of the tension in a controlled manner during the deforming procedure and the formation of a single depression.

However, Ellison teaches that it is old and well known in the art of article molding to control the reduction of film tension in the formation of a single depression receptacle while allowing the film to move into the cavity during a deformation process for the purpose of manufacturing a part of uniform thickness while reducing thinning (See figure 1, para. 0013 and 0029).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the tension control means as taught by Ellison for the purpose of manufacturing a part of uniform thickness.

In claim 3, the modified invention of Patterson, through Patterson discloses the invention as claimed including controlling the tension by applying retaining pressure to pad 100 in the peripheral regions 162 (See Patterson, figure 6 and col. 5, lines 21-39).

In claims 4-6, the modified invention of Patterson, through Patterson discloses the invention as claimed including, the peripheral regions moving parallel toward one another as the material is stretched in the die.

In claim 7, the modified invention of Patterson, through Patterson discloses the invention as claimed including forming substantially crease free regions 68 and controlled crease regions (in the area of 36) (See Patterson, figure 2).

In claims 8 and 9, the modified invention of Patterson, through Patterson discloses the invention as claimed including heating the web to a controlled temperature prior to deformation, where the temperature is lowered by the transfer of heat into the web (See Patterson, col. 6, lines 23-33).

In claims 14 and 15, the modified invention of Patterson, through Patterson discloses the invention as claimed including an unheated negative mold 52 and a heated positive mold brought to a constant temperature prior to forming (See Patterson, col. 6, lines 23-33).

In claims 17 and 18, the modified invention of Patterson, through Patterson discloses the invention as claimed including heating and deforming the web between a positive and negative mold 54 and 52, and a recovery time after the web has been formed and prior to the loading of the next web, which can be several seconds long (See Patterson, figures 2,3,6,7 and col. 3, line 43 – col. 4, line 64). Additionally, Ellison teaches that it is old and well known in the art to relieve the tension in a controlled manner (See Ellison, page 1, para. 0013).

In claim 19 and 20, the modified invention of Patterson, through Patterson discloses the invention as claimed including the film web being delivered in cycles as blanks are formed by stamp 22 and 24 (See Patterson, figure 1 and col. 3, lines 43-61).

In claims 21 and 28 Patterson discloses the invention as claimed including permanently deforming a sheet of film 28, by providing a positive and negative molds 54 and 52 respectively, having an edge portion and upper portion, forming depressions 70, which the tension is controlled by draw pads 100, while forming controlled creases (in the area of 36) around the edges of the material, while the upper edge (i.e. the clamped edges) are kept in a flat original shape and filling the depression with food (See figures 2, 3, 6, 7, col. 1, lines 10-22 and col. 3, line 43 – col. 4, line 64). What Patterson does not disclose is the reduction of the tension in a controlled manner during the deforming procedure.

However, Ellison teaches that it is old and well known in the art of article molding to control the reduction of film tension in the formation of a single depression receptacle while allowing the film to move into the cavity during a deformation process for the

purpose of manufacturing a part of uniform thickness while reducing thinning (See figure 1, para. 0013 and 0029).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the tension control means as taught by Ellison for the purpose of manufacturing a part of uniform thickness.

In claims 25 and 27, Patterson discloses the invention as claimed including permanently deforming a sheet of film 28, using positive and negative molds 54 and 52, having an edge portion and upper portion, for forming depressions 70, where the tension is controlled and maintained by draw pads 100, while forming controlled creases (in the area of 36) around the edges of the material, while the upper edge (i.e. the clamped edges) are kept in a flat original shape and heating means 172 and 174 (See figures 2, 3, 6, 7 and col. 3, line 43 – col. 4, line 64). What Patterson does not disclose is the reduction of the tension in a controlled manner during the deforming procedure.

However, Ellison teaches that it is old and well known in the art of article molding to control the reduction of film tension in the formation of a single depression receptacle while allowing the film to move into the cavity during a deformation process for the purpose of manufacturing a part of uniform thickness while reducing thinning (See figure 1, para. 0013 and 0029).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the tension control means as taught by Ellison for the purpose of manufacturing a part of uniform thickness.

3. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison in view of Prena (US 3,762,125).

The modified invention of Patterson discloses the invention as claimed as applied to claim 1 above except for the use of indicia on the web of material, which is deformed during the packaging process. However, Prena teaches that it is old and well known in the art of packaging to provide a film "F" with printed and undistorted indicia marks 48, which are stretched and deformed by rollers 36 and 38 prior to packaging for the purpose of correctly orienting a film prior to filling (See figure 3 and col. 5, lines 26-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the film deformation means as taught by Prena for the purpose of correctly orienting a film prior to filling.

4. Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison in view of Fujii (US 4,124,421).

The modified invention of Patterson discloses the invention as claimed as applied to claims 1 and 13 above except for the use of a vacuum source to assist in the deformation process. However, Fujii teaches that it is old and well known in the art of package forming to utilize a vacuum source 46, located in a female die for the purpose of forming a package with a defined depression (see figure 3 and col. 4, lines 12-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the vacuum means as taught by Fujii for the purpose of forming a package with a defined depression.

5. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson and Ellison in view of Porteous (US 5,009,056).

The modified invention of Patterson discloses the invention as claimed as applied to claim 21 above except for introducing the food in a free flowing state and sealing the package after filling. However, Porteous teaches that it is old and well known in the art to form a package from a web of material 14, where the package is filled with a material in a free flowing state and subsequently sealed by heat bonding for the purpose of efficiently forming and filling a package (see figures 3, 5, 8 and col. 4, line 4 – col. 5, line 14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Patterson with the forming and filling means as taught by Porteous for the purpose of efficiently forming and filling a package.

Response to Arguments

6. Applicant's amendments to claims 1, 21 and 25 overcomes the rejection set forth under 35 U.S.C. § 112, 2nd para. The rejection has been withdrawn.

7. Applicant's arguments filed 4/8/2008 have been fully considered but they are not persuasive.

Applicant first argues that under the *Graham* factors, the combined primary reference of Patterson and teaching of Ellison do not disclose all of the limitations of the claims, including the arrangement of creases along the entire lower edge portion of the

mould. Moreover, applicant argues that the combined references do not disclose controlling and reducing the tension of the film, while allowing film material to penetrate between the positive and negative film molds. This argument is not persuasive.

As applicant is aware, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The examiner does agree with applicant that the neither the level of ordinary skill in the art nor secondary considerations are applicable to the present case. Applicant has not submitted any objective evidence which would be applicable to a secondary consideration of non-obviousness. Moreover, the examiner asserts that the present invention and cited prior art adequately reflects the level of ordinary skill in the art as all are generally concerned with pressure molding of packages. *See generally* MPEP §§ 2141, 2141.03.

Applicant's assertion that the combined references of Patterson and Ellison do not teach the arrangement of creases along the entire lower edge portion of the mold is not correct. First, the examiner cannot find support in the specification for this limitation as neither the specification, not the drawings explicitly disclose this limitation. Moreover, the term "lower edge portion" introduces a level of ambiguity into the claim. Is the lower edge a bottom portion of the mold or is a lip portion arranged around the

edge of a mold? Additionally, it is unclear from the claim which mold is actually being claimed.

In Patterson, which is being relied on for this pertinent limitation, the blank is initially scored prior to insertion into the mold. As the tray is formed, the scored portions form creased portions around the walls of the tray. Alternatively, in view of the ambiguity of relevant limitation, a lateral fold can also encompass the lip of the tray, which is creased around the tray or the sidewalls of the individual compartments.

Additionally and in regard to the process claims, the wherein clause of the claims, followed by the pertinent recitation is not a positive limitation, but rather discloses the intended result of the process step positively recited above. *See* MPEP § 2111.04. In the apparatus claims, this clause is a functional recitation of the intended use of the apparatus and cannot serve as the basis of for patentability as the apparatus must be distinguished in terms of structure rather than structure. *See* MPEP § 2114.

Applicant further argues that the combination of Patterson and Ellison do not disclose controlling and reducing the tension of the film, while allowing film material to penetrate between the positive and negative film molds. The examiner does not agree with this argument.

Although the primary reference of Patterson does not disclose the adjustability of the clamping means, the examiner has relied on the teaching of Ellison to show applicant that it is old and well known to provide this limitation on a molding machine to prevent thinning and even breakage of the material during a formation process. One cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As the combined references disclose this limitation the rejection is proper.

Applicant lastly argues that the dependant claims are allowable as the independent claims are allowable. This argument is not persuasive as the examiner has maintained the rejection of the independent claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Durand whose telephone number is (571)272-4459. The examiner can normally be reached on 0830-1700, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul R. Durand/
Patent Examiner, Art Unit 3721

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721

July 23, 2008